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EXAMINER

ASHLEY, BOYER DOLINGER

ART UNIT PAPER NUMBER

3724

DATE MAILED: 12/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/676,190

Applicant(s)

GASS, STEPHEN F.

Examiner

Boyer D. Ashley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-35 is/are pending in the application.
- 4a) Of the above claim(s) 21-24, 28 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-27 and 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 24, 30, 31.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/3/03 has been entered, wherein claims 25, 27, 29, 31, 32 were amended and claim 35 was added.

It should be noted that for the purpose of this office action the below rejections under 35 U.S.C. 101 (double patenting) are being made under the assumption that the applications were not commonly owned at the time of applicant's invention. It should further be noted that rejections under 35 U.S.C 102(a) and 102(e) using the same U.S. Patent Applications/Publications have not been made because they do ^{NOT} qualify as prior art as their filing dates are not before the filing date of the instant application. 8

Additionally, it should be noted that the below double patenting rejections are based upon known and available co-pending applications and although it is believed that all appropriate rejections have been made, Applicant's help in determining all appropriate double patenting rejections with all of Applicant's applications is requested because of the large number of similar applications.

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Election/Restrictions

2. Newly submitted claim 35 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Applicant's election of Species I in Group A corresponds to Figure 20, which includes miter saws not table saws. Claim 35 is directed to a table saw and therefore, was nonelected.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 35 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Priority

3. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(e). See 37 CFR 1.78.

SPECIAL CIRCUMSTANCES OF THIS APPLICATION:

4. Even if a copending application is listed as a parent to the instant application and material information is technically of record in one or more parent applications, the unusually large number of applicant's cases in varying stages of the examination process might result in one or more parent applications not being readily available for review, or material information of record not being readily apparent. Applicant should point out such material information to the examiner of the instant application if the criteria for materiality applies, and if the examination record provides applicant reason to believe such information has not been considered by the examiner.

If, to the best of applicant's knowledge, applicant has no previous patent or copending application, which would meet the definition of "material," applicant is requested to make a statement of that fact of record.

Any parent application labeled as a CIP or Divisional is assumed to claim a patentably distinct invention from the claims of this application and therefore the issue of double patenting has not been considered and the rights to priority are limited to the common disclosed subject matter unless it is brought to the examiners attention that some claims are not distinct.

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37 CFR 1.56 is cited here:

37 CFR 1.56. Duty to disclose information material to patentability.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney, or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 25-27, 29-31, and 34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 09/929,238, U.S. Patent Application Publication 2002/0017179. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ in claim terminology used but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 32-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 09/929,238, U.S. Patent application publication 2002/0017179, as applied to claims 25-27, 29-31 and 34 above and further in view of Lokey, U.S. Patent 3,785,230.

The claims of '238 discloses the invention substantially as claimed except for the braking system including a pawl to engage the blade; however, Lokey discloses that it is old and well known in the art to use braking systems with pawls that engage blades for the purpose of ensuring positive engagement and stopping of the blade. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use pawl with the braking system of claims of '238 in order to positively engage and stop the blade.

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The modified claimed device of '238 lacks the specific location of the braking pawl being at the front of the blade away from the pivot joint. It would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the braking pawl of the claimed device of '238 at the front of the blade in order to spread the weight of the device out over the length of the pivot arm to facilitate pivoting of the arm, because it has been held that rearranging parts of an invention involves only routine skill in the art.

This is a provisional obviousness-type double patenting rejection.

8. Claims 25-27, 29-31, and 34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-11 of copending Application No. 09/929,242. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ in claim terminology used but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 32-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-11 of copending Application No. 09/929,242, U.S. Patent application publication 2002/0017181, as applied to claims 25-27, 29-31 and 34 above and further in view of Lokey, U.S. Patent 3,785,230.

The claims of '242 discloses the invention substantially as claimed except for the woodworking machine being a miter saw and the braking system including a pawl to

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engage the blade; however, Lokey discloses that it is old and well known in the art to use braking systems with pawls that engage blades with many different types of woodworking tools, such as conventional saws and table saws, for the purpose of ensuring positive engagement and stopping of the blade when making different types of cuts in a workpieces. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use pawl with the braking system of claims of '242 with a miter saw in order to positively engage and stop the blade when making a specific type of cut in a workpiece.

The modified claimed device of '242 lacks the specific location of the braking pawl being at the front of the blade away from the pivot joint. It would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the braking pawl of the claimed device of '242 at the front of the blade in order to spread the weight of the device out over the length of the pivot arm to facilitate pivoting of the arm, because it has been held that rearranging parts of an invention involves only routine skill in the art.

This is a provisional obviousness-type double patenting rejection.

10. Claims 25-27, 29-31, and 34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/052,273, U.S. Patent Application Publication 2002/0059853. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ in claim terminology used but encompass the same subject matter.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 32-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 10/052,273, U.S. Patent application publication 2002/0059853, as applied to claims 25-27, 29-31 and 34 above and further in view of Lokey, U.S. Patent 3,785,230.

The claims of '273 discloses the invention substantially as claimed except for the braking system including a pawl to engage the blade; however, Lokey discloses that it is old and well known in the art to use braking systems with pawls that engage blades for the purpose of ensuring positive engagement and stopping of the blade. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use pawl with the braking system of claims of '238 in order to positively engage and stop the blade.

The modified claimed device of '273 lacks the specific location of the braking pawl being at the front of the blade away from the pivot joint. It would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the braking pawl of the claimed device of '273 at the front of the blade in order to spread the weight of the device out over the length of the pivot arm to facilitate pivoting of the arm, because it has been held that rearranging parts of an invention involves only routine skill in the art.

This is a provisional obviousness-type double patenting rejection.

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12. Claims 25-27, 29-31, and 34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/050,085, U.S. Patent Application Publication 2002/0056349. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ in claim terminology used but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 32-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/050,085, U.S. Patent application publication 2002/0056349, as applied to claims 25-27, 29-31 and 34 above and further in view of Lokey, U.S. Patent 3,785,230.

The claims of '085 discloses the invention substantially as claimed except for the braking system including a pawl to engage the blade; however, Lokey discloses that it is old and well known in the art to use braking systems with pawls that engage blades for the purpose of ensuring positive engagement and stopping of the blade. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use pawl with the braking system of claims of '085 in order to positively engage and stop the blade.

The modified claimed device of '085 lacks the specific location of the braking pawl being at the front of the blade away from the pivot joint. It would have been

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obvious to one having ordinary skill in the art at the time the invention was made to locate the braking pawl of the claimed device of '085 at the front of the blade in order to spread the weight of the device out over the length of the pivot arm to facilitate pivoting of the arm, because it has been held that rearranging parts of an invention involves only routine skill in the art.

This is a provisional obviousness-type double patenting rejection.

14. Claims 25-27, 29-31, and 34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/047,066, U.S. Patent Application Publication 2002/0056348. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ in claim terminology used but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 32-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/047,066, U.S. Patent application publication 2002/0056348, as applied to claims 25-27, 29-31 and 34 above and further in view of Lokey, U.S. Patent 3,785,230.

The claims of '066 discloses the invention substantially as claimed except for the braking system including a pawl to engage the blade; however, Lokey discloses that it is old and well known in the art to use braking systems with pawls that engage blades for

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the purpose of ensuring positive engagement and stopping of the blade. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use pawl with the braking system of claims of '066 in order to positively engage and stop the blade.

The modified claimed device of '066 lacks the specific location of the braking pawl being at the front of the blade away from the pivot joint. It would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the braking pawl of the claimed device of '066 at the front of the blade in order to spread the weight of the device out over the length of the pivot arm to facilitate pivoting of the arm, because it has been held that rearranging parts of an invention involves only routine skill in the art.

This is a provisional obviousness-type double patenting rejection.

16. Claims 25-27, 29-31, and 34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/100,211, U.S. Patent Application Publication 2002/0170399. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ in claim terminology used but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 32-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of

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copending Application No. 10/100,211, U.S. Patent application publication 2002/0170399, as applied to claims 25-27, 29-31 and 34 above and further in view of Lokey, U.S. Patent 3,785,230.

The claims of '211 discloses the invention substantially as claimed except for the braking system including a pawl to engage the blade; however, Lokey discloses that it is old and well known in the art to use braking systems with pawls that engage blades for the purpose of ensuring positive engagement and stopping of the blade. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use pawl with the braking system of claims of '211 in order to positively engage and stop the blade.

The modified claimed device of '211 lacks the specific location of the braking pawl being at the front of the blade away from the pivot joint. It would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the braking pawl of the claimed device of '211 at the front of the blade in order to spread the weight of the device out over the length of the pivot arm to facilitate pivoting of the arm, because it has been held that rearranging parts of an invention involves only routine skill in the art.

This is a provisional obviousness-type double patenting rejection.

18. Claims 25-27, 29-31, and 34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 09/929,238, U.S. Patent Application Publication 2002/0017179. Although the conflicting claims are not identical, they are

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not patentably distinct from each other because they differ in claim terminology used but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

19. Claims 32-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 09/929,238, U.S. Patent application publication 2002/0017179, as applied to claims 25-27, 29-31 and 34 above and further in view of Lokey, U.S. Patent 3,785,230.

The claims of '238 discloses the invention substantially as claimed except for the braking system including a pawl to engage the blade; however, Lokey discloses that it is old and well known in the art to use braking systems with pawls that engage blades for the purpose of ensuring positive engagement and stopping of the blade. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use pawl with the braking system of claims of '238 in order to positively engage and stop the blade.

The modified claimed device of '238 lacks the specific location of the braking pawl being at the front of the blade away from the pivot joint. It would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the braking pawl of the claimed device of '238 at the front of the blade in order to spread the weight of the device out over the length of the pivot arm to facilitate pivoting

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of the arm, because it has been held that rearranging parts of an invention involves only routine skill in the art.

This is a provisional obviousness-type double patenting rejection.

20. Claims 25-27 and 29-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 09/929,235, U.S. Patent application publication 2002/0017184, as applied to claims 25-27, 29-31 and 34-35 above and further in view of Lokey, U.S. Patent 3,785,230.

The claims of '235 discloses the invention substantially as claimed except for the woodworking machine being a miter saw and the braking system including a pawl to engage the blade; however, Lokey discloses that it is old and well known in the art to use braking systems with pawls that engage blades with many different types of woodworking tools, such as conventional saws and table saws, for the purpose of ensuring positive engagement and stopping of the blade when making different types of cuts in a workpieces. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use pawl with the braking system of claims of '235 with a miter saw in order to positively engage and stop the blade when making a specific type of cut in a workpiece.

The modified claimed device of '235 lacks the specific location of the braking pawl being at the front of the blade away from the pivot joint. It would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the braking pawl of the claimed device of '235 at the front of the blade in order to

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spread the weight of the device out over the length of the pivot arm to facilitate pivoting of the arm, because it has been held that rearranging parts of an invention involves only routine skill in the art.

This is a provisional obviousness-type double patenting rejection.

21. Claims 25-27 and 29-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 09/955,418, U.S. Patent application publication 2002/0020265, as applied to claims 25-27, 29-31 and 34-35 above and further in view of Lokey, U.S. Patent 3,785,230.

The claims of '418 discloses the invention substantially as claimed except for the woodworking machine being a miter saw and the braking system including a pawl to engage the blade; however, Lokey discloses that it is old and well known in the art to use braking systems with pawls that engage blades with many different types of woodworking tools, such as conventional saws and table saws, for the purpose of ensuring positive engagement and stopping of the blade when making different types of cuts in a workpieces. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use pawl with the braking system of claims of '418 with a miter saw in order to positively engage and stop the blade when making a specific type of cut in a workpiece.

The modified claimed device of '418 lacks the specific location of the braking pawl being at the front of the blade away from the pivot joint. It would have been obvious to one having ordinary skill in the art at the time the invention was made to

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locate the braking pawl of the claimed device of '418 at the front of the blade in order to spread the weight of the device out over the length of the pivot arm to facilitate pivoting of the arm, because it has been held that rearranging parts of an invention involves only routine skill in the art.

This is a provisional obviousness-type double patenting rejection.

Comments on Commonly Assigned Applications

22. Claims 25-27 and 29-34 are directed to an invention not patentably distinct from the claims, see above, of commonly assigned applications, for the reasons stated above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned applications, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon

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the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Claim Rejections - 35 USC § 102

23. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

24. Claims 25-27 and 29-34 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

It is not clear who actually invented the subject matter of claims 25-27 and 29-34 because the above co-pending applications have different inventive entities. Therefore, it is not clear which portion of the applications where invention by the same inventive entity of the instant application.

Claim Rejections - 35 USC § 103

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claims 25-27 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosten et al., U.S. Patent 5,285,708, or Meredith, U.S. Patent

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5,724,875, in view of Lokey, U.S. Patent 3,785,230, and Terauchi, U.S. Patent 4,512,224.

Bosten et al. and Meredith et al. both disclose the invention substantially as claimed except for the detection system and the brake system; but includes, e.g., a base (16), a work surface (18/20), rotatable blade (36), a motor (34), a pivot joint (30), and a support arm (28). The detection system is configured to detect a dangerous condition between a person and the blade. The brake system engages the blade upon detection of the dangerous condition and configured to use at least part of the angular momentum of the blade to generate a force tending to urge the axis of the blade away from the work surface.

Lokey discloses that it is old and well known in the art to use detection and braking system for the purpose of preventing injury to a user, wherein the brake systems of Lokey is located on the front of the guard of the rotating saw such that angular momentum of the blade is transferred to the blade housing upon activation of the brake. The braking system of Lokey also includes pawls to engage the blade.

Terauchi discloses that it is old and well known in the art to use safety systems that includes immediate stopping of the blade or retraction of the a blade when the blade contacts a workpiece holder for the purpose of preventing damage or further damage to the workpiece holder.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a detection system and a braking system, as taught by Lokey and Terauchi with the devices of Bosten et al. or Meredith et al. such

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that the angular momentum of the blade is used to urge the blade away from the work surface in order to prevent injury to the user by retracting the blade upon detection of a dangerous condition.

Furthermore, the examiner maintains that the recitation "configured to use at least part of the angular momentum of the blade to generate a force tending to urge the axis around which the blade rotates away from the work surface when the brake system engages the blade" is merely intended use with defining any specific structure that allows for this intended use. The modified devices of Bosten et al. and Meredith et al. are clearly capable of using part of the angular momentum of the blade to generate a force urging the axis away from the work surface based upon the location of the brake on the blade housing, the speed of rotation of the blade, the length of the pivot arm, the weight of the pivot arm, the location of the arm relative to the work surface, location of the brake in the radial direction of the blade.

As to claim 33, the modified devices of Bosten et al. and Meredith et al. both disclose the invention substantially as claimed except for the specific location of the brake relative to the pivot joint. However, Lokey discloses that it is old and well known in the art to use brakes on the front of a blade, with counterclockwise rotation of the blade as seen in Figure 1, wherein the brake on the opposite side of the pivot arm. In this case, the pivot arm would be the arm of user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a brake on the front side of the modified devices of Bosten et al. and Meredith et al. if the blade of modified device rotated in the clockwise direction in order to positively engage

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the blade to prevent further movement of the blade by having the blade facilitate movement of the brake pawls into the blade to bind the blade with brake.

Response to Arguments

27. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's comments regarding functional/intended use language. Although, it is true that it is well established that applicant's can use functional language to describe their invention. It should be noted that these functional language statements must refer to structure for performing these functions, in that, apparatus claims must be structurally distinguishable from the prior art. See MPEP 2114.

Furthermore, it should be noted that it also well established that intended use statements only require the prior art to be capable of performing the intended use.

In this case the claims do not suggest or imply any specific structure. Therefore, the prior art merely needs to be capable of performing the functions/intended use statements. Moreover, it is not clear what structure other than a brake on the blade housing that allows for these intended use statements of the brake system. How are the claims of the instant application and disclosed device any different from the prior art. See MPEP 2106, 2111.02, 2114. See further comments below.

Response to Amendment

28. The declaration under 37 CFR 1.132 filed 10/3/03 is insufficient to overcome the rejection of claims 25-27 and 29-34 based upon Bosten et al. in view of Lokey as set forth in the last Office action because it fails to set forth facts, moreover the declaration

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is not germane to the new grounds of rejection; and the showing is not commensurate in scope with the claims.

In this case, the declaration only gives the opinion of the applicant as to what would happen if Bosten et al. included a brake on the pivot arm (28) base upon tests the applicant allegedly performed. However, the declaration does not give any proof or information as to the tested devices other than to say that they are similar. How are they similar? The declaration fails to provide any proof that the instant application performs as alleged and does not provide any proof that Bosten et al. would work as alleged. The declaration provides no nexus between the claimed invention and the tested devices or that of alleged device. What structure is in the instant application claims that is not in the prior art?

Applicant's declaration further contends that any braking of the blade of Bosten et al. would cause the pivot arm to move downward no matter where the brake is placed on the device of Bosten et al. If this is case what structure allows the instant application to move upward when the brake would/could be located in similar locations.

In any event, it should be noted that even if it is argued or true that the modified device urges the blade downward by the angular momentum it is equally true that the a portion of the angular momentum does jerk the blade upward even if it is true that the majority of the angular momentum causes downward movement depending upon the location of the brake. For instance, if the brake is located near the rotational axis and on the closest to the pivot joint for counterclockwise rotation or on the front for clockwise rotation.

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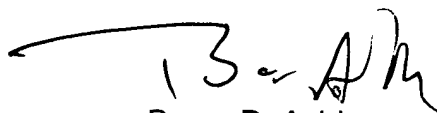
Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

A handwritten signature in black ink, appearing to read 'B. Ashley', with a long horizontal stroke extending to the left.

Boyer D. Ashley
Primary Examiner
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BDA
December 27, 2003